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28393	7590	12/17/2003		EXAMINER
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.			TRAN, MY CHAU T	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20031208

Application Number: 09/721,508

Filing Date: November 22, 2000

Appellant(s): PARCE ET AL.

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Linda E. Alcorn  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 14, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

However, it is noted that the pending claims (Claims 75-90) were copied from U.S. Patent 6,103,199 by appellants in an effort to provoke an interference.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The amendment following the brief is acknowledged and entered. Claims 91-107 are canceled by the amendment.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 78, 81, and 87 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 78, 81, and 87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 78 and 81 recites an apparatus that includes an array of sample wells, which conform to a format of a 96, 192, 384, or 1536 well plate.

Claim 87 recites a method in which an array of sample is from an array of sample wells. The array of sample wells conforms to a format of a 96, 192, 384, or 1536 well plate.

The specification discloses an apparatus that include bead resting wells (pg. 28, lines 34-38) and an apparatus that contained multiwell micro plates (pg. 36, line 14; ref. #711 of fig. 7). A method in which test compounds are immobilized on beads in a parallel assay system the parallel channels may be fabricated to include bead resting wells (pg. 28, lines 24-38).

Nowhere in the specification is there a teaching of sample wells that conform to a format of a 96, 192, 384, or 1536 well plate. Additionally in the multiwell micro plates (ref. #711) of fig. 7, the wells are not in a format of a 96 well plate.

In the event that applicant believes support for the amendment is available in the specification. It is respectfully requested that applicant point to the page and line number where such support maybe found.

#### ***(11) Response to Argument***

Claims 78, 81, and 87 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

## ***DISCUSSION***

It is noted that appellants have addressed the supra rejection as “lack of written description” whereas the examiner has set forth as “new matter” rejection. However, appellants’ argument is still pertinent to the rejection under 35 U.S.C. 112, first paragraph, (new matter).

Appellants argue that the specification provides adequate written description for sample wells with the format of a 96, 192, 384, or 1536 well plate since the specification of the present invention discloses multi-well microplates that are used in a system that screens *large numbers* of compounds. This description clearly satisfied the written description requirement for a *multi-well* microplate.

Appellants’ arguments have been considered but are not persuasive because the term “multi-well” microplate embraces a multitude of different formats of sample wells. Consequently, the specification’s disclosure of multi-well microplates that are used in a system that screens *large numbers* of compounds does not provide specific support that appellants had possession of the particularly claimed sample wells with the format of a 96, 192, 384, or 1536 well plate as required by statute.

Appellants argue that the specific well formats of a 96, 192, 384, or 1536 well plate are well known in the art wherein many patents filed prior to the effective filing date of the present application disclose these standard well plate arrangements. The particular patents provided by the appellants are U.S. Pat. No. 5,508,005, U.S. Pat. No. 5,604,130, U.S. Pat. No. 5,560,811, U.S. Pat. No. 5,753,511, U.S. Pat. No. 6,100,026, U.S. Pat. No. 6,319,668.

Appellants’ arguments have been considered but are not persuasive because the issue is whether appellants had possession of sample wells with the format of a 96, 192, 384, or 1536

well plate not whether the patents filed prior to the effective filing date of the present application had possession of sample wells with the format of a 96, 192, 384, or 1536 well plate. The sample wells formats disclosed by U.S. Pat. No. 5,508,005 (e.g. sample wells format of a 96, and 192 well plates), U.S. Pat. No. 5,604,130 (e.g. sample wells format of a 96, and 384 well plates), U.S. Pat. No. 5,560,811 (e.g. sample wells format of a 96, 192, and 384 well plates), U.S. Pat. No. 5,753,511 (e.g. sample wells format of a 96, and 384 well plates), U.S. Pat. No. 6,100,026 (e.g. sample wells format of a 192, 384, and 1536 well plates), and U.S. Pat. No. 6,319,668 (e.g. sample wells format of a 96, 384, and 1536 well plates) would not provide support that appellants had possession of sample wells with the format of a 96, 192, 384, or 1536 well plate. Therefore, appellants do not have possession of sample wells with the format of a 96, 192, 384, or 1536 well plate.

Appellants argue that the combination of the term “multi-well” microplates in the specification and that the specific well formats of a “96, 192, 384, or 1536” well plate are well known in the art demonstrate that an adequate written description for the specific well plate formats in claims 78 and 87.

Appellants’ arguments have been considered but are not persuasive, since the term “multi-well” microplates includes several different formats of sample wells and one of skill in the art would not envision that the term “multi-well” microplates would be specifically for sample wells formats of a 96, 192, 384, or 1536 well plate. Therefore, the mere recitation of the term “multi-well” microplates in the specification is not adequate support for the specifically claimed well formats of a “96, 192, 384, or 1536” well plate as claimed in claim 78 and 87.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Examiner My-Chau Tran  
December 12, 2003

Conferees  
Supervisory Patent Examiner Andrew Wang  
Primary Examiner Padmashri Ponnaluri



ANDREW WANG  
SUPervisory PATENT EXAMINER  
TECHNOLOGY CENTER 1600

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, NW  
SUITE 600  
WASHINGTON, DC 20005-3934



PADMASHRI PONNALURI  
PRIMARY EXAMINER